UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,940	09/16/2003	Kimball C. Chen	64171.000002	2033

21967   7590   08/04/2011

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
2200 Pennsylvania Avenue, N.W.
WASHINGTON, DC 20037

EXAMINER
BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
3628	

MAIL DATE	DELIVERY MODE
08/04/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1   RECORD OF ORAL HEARING
2
3   UNITED STATES PATENT AND TRADEMARK OFFICE
4   _____
5
6   BEFORE THE BOARD OF PATENT APPEALS
7   AND INTERFERENCES
8   _____
9
10   *Ex parte* KIMBALL C. CHEN, ALEXANDER W. EVANS,
11   and DANIEL E. SHPRECHER
12   _____
13
14   Appeal 2010-000055
15   Application 10/662,940
16   Technology Center 3600
17   _____
18
19   Oral Hearing Held: January 20, 2011
20   _____
21
22   Before HUBERT C. LORIN, ANTON W. FETTING, and
23   JOSEPH A. FISCHETTI, *Administrative Patent Judges.*
24
25   APPEARANCES:
26
27   ON BEHALF OF THE APPELLANT:
28
29   YISUN SONG, ESQUIRE
30   Hunton & Williams, LLP
31   1900 K Street, N.W.
32   Suite 1200
33   (202) 955-1966
34
35
36   The above-entitled matter came on for hearing on Thursday, January

37   20, 2011 commencing at 10:19 a.m., at the U.S. Patent and Trademark

1   Office, 600 Dulany Street, Alexandria, Virginia, before Deborah Rinaldo,

2   Notary Public.

3   P R O C E E D I N G S

4   JUDGE LORIN: Good morning, Ms. Song. Counsel, we're familiar

5   with the record. When you are ready, you may proceed. You have

6   20 minutes.

7   MS. SONG: Thank you very much. Good morning. My name is

8   Yisun Song. I'm with the law firm of Hunton & Williams. I'm here today

9   on behalf of our client ETGI to discuss the merits of this pending

10 application.

11   I would like to address just a couple of points this morning and I will

12 start with a brief summary of the pending claims and then I'll address the

13 103 rejections.

14   The pending claims are directed to a system and method for

15 automatically generating a message to control remote devices. The claims

16 recite a recursive method where an informational message is generated in

17 response to operational characteristics of remote devices. The pending

18 application was filed September 2003 and claims priority as far as back as

19 January 1999.

20   There are two independent claims and 11 dependent claims at issue

21 and the remaining claims have been withdrawn.

22   Claim 1 recites a computer-implemented method and claim 1A recites

23 a computer-implemented system. There are two main steps for these

24 independent claims. The first step requires automatically generating one --

25 at least one informational message at a central server responsive to some

26 type of operational characteristic of the remote devices.

1   The second step requires transmitting the informational message to a

2   communication device where the communication device initiates an action

3   from the remote devices.

4   So we have three components. One a central server that automatically

5   generates the informational message; two, a communication device that

6   receives the informational message and then controls the remote devices;

7   and three, the remote devices themselves that provide operating

8   characteristics to the central server so that the central server can then

9   automatically generate the informational message.

10   So the remote devices are monitored and that monitored data is used

11   by the central server to then automatically generate informational messages

12   to control the remote devices. So you see that there is a recursive feature to

13   the claimed invention.

14   In addressing the claims the Examiner relies on a combination of two

15   patents, the Brown patent and the Woodard patent. Brown does not disclose

16   this recursive feature. The Examiner alleges that Brown shows all the claim

17   limitations except for the server. However, this is not accurate.

18   Brown does not show this automatic generation of an informational

19   message at a central server responsive to some type of operational

20   characteristic of remote devices.

21   To address this feature, the Examiner relies on Brown's discussion of

22   a central computer 24 providing signals to transmitter 20 which in turn

23   provides paging messages to controllers 14. These messages may cause

24   certain appliances to be turned off. At best Brown discloses a one-way

25   communication channel for sending paging signals from a computer to a

26   controller.

1   Brown does not monitor the remote devices nor does it use any

2   monitored data to generate the pages to control the remote devices. Rather,

3   Brown's central computer operates on a predetermined schedule. According

4   to Brown, the controller schedules each device to be operated pursuant to the

5   program schedule. As defined by Brown, the schedule refers to scheduling

6   the time of day and appropriate times for device operation.

7   Alternatively, Brown very clearly states that the user of the system

8   may cause a paging message to be provided at any time. Thus, Brown

9   teaches that the remote devices may be controlled in three ways, one by a

10 predetermined schedule which refers to day and time of operation, two as

11 determined by a user or, three, as determined by a utility company.

12   It does not automatically control remote devices responsive to any

13 operating characteristic of the actual remote devices themselves. There is no

14 recursive feature in Brown. The paging system relied upon by the Examiner

15 can only generate one-way pages from the computer to the devices.

16   There is no way to automatically generate a message responsive to the

17 operating characteristics of the devices because Brown does not monitor the

18 remote devices for the purpose of generating the paging messages.

19   In attempting to address this claim, the Examiner appears to ignore the

20 requirement that the informational message is generated responsive to the

21 remote devices.

22   During patent examination the pending claims must be given the

23 broadest reasonable interpretation consistent with the specification. Each

24 claim limitation must have meaning and cannot be interpreted to be devoid

25 of any meaning.

1   The Examiner has the burden to show where in the reference each

2   claim limitation is found. The Examiner must meet this burden, however,

3   without interpreting claims in a manner that would render any limitation

4   meaningless.

5   In the Examiner's answer at page 6 the Examiner relies on Brown

6   column 4, lines 4 through 18, which makes clear that the central computer

7   generates pages that are not responsive to any operating characteristic of the

8   remote devices.

9   From their relied-upon excerpt, Brown clearly teaches that the central

10 computer provides signals to the transmitter. The paging messages are

11 generated as a result of actions by the central computer. There is nothing

12 from these passages from Brown that indicates that the central computer

13 generates pages responsive to any operating characteristics of the remote

14 devices. There is no recursive feature in Brown.

15   JUDGE FISCHETTI: Counsel, you've said now several times

16 recursive. I'm looking in the claim and I assume by recursive you mean a

17 feedback loop type of recursive?

18   MS. SONG: Yes, exactly.

19   JUDGE FISCHETTI: That would, to me, strike some sort of cyclic

20 reiterative language. I don't see that. Maybe you could show me.

21   MS. SONG: Sure. Absolutely. In claim 1, for example, we say

22 automatically generating at least one informational message at a server and

23 then we have the phrase "responsive to" and then we go into a couple of

24 different ways one or more of resource consumption, resource production,

25 operating characteristics or operational state of at least one device of the

26 plurality of remote devices.

5

1   So the automatic generation has to be responsive to one of those

2   characteristics of the remote devices. What Brown teaches is some sort of

3   user intervention or some sort of preestablished, predetermined program that

4   generates the paging messages.

5   JUDGE FISCHETTI: Wouldn't that be an operational state of

6   preprogrammed operational state, customized operational state that it's

7   responding to?

8   MS. SONG: Well, the predetermined schedule has to do -- according

9   to Brown, has to do with day and time of operation. That, we believe, is

10   separate from the actual operating characteristic of the remote devices. A

11   predetermined schedule as Brown really tells you when and what time and

12   during the time frame of operation of the remote devices. If you were to go

13   on vacation or at night if you don't need to turn on the heater, you can --

14   JUDGE FISCHETTI: So you are going from on to off or off to on,

15   right? You are changing states according to a schedule?

16   MS. SONG: It's a predetermined schedule and it's not responsive to

17   the actual remote devices and how they operate. And that's what the claims

18   are trying to --

19   JUDGE FISCHETTI: Assuming -- where is the reiterative aspect of

20   this? We understand that it's responsive but you say that it's recursive, and

21   so where after this one event in the claim do I see the continuing cyclic of

22   these events?

23   MS. SONG: I used the term recursive because I didn't want to have to

24   repeat the entire claim language, but what I meant by recursive is that the

25   informational message is generated responsive to the remote devices and

26   that can change. That can kind of keep going over time.

1   According to Brown, it's on a predetermined schedule. The user can

2   say send this page message now and control the device. Here it can

3   continuously happen as it's monitoring the devices, as the device is changing

4   in operation. The informational message that controls the device will also,

5   in turn, change as well.

6   JUDGE FISCHETTI: So it's a feedback but I don't see where it's

7   claimed as that, unfortunately.

8   MS. SONG: Well, we believe the term "responsive to" would have to

9   imply that the -- and in conjunction with the term "automatically generating"

10   the message has to be automatically generated responsive to these operating

11   characteristics of the remote devices. So that precludes any sort of user

12   intervention, any sort of preprogram schedule.

13   JUDGE FISCHETTI: When you say it precludes user intervention, I

14   look at column 4 and it says that the utility command center computer

15   provides signals to a transmitter. So that statement is said exclusive of

16   human intervention as it's written. So why would I want to assume that

17   there is human intervention in the text when it's not there?

18   MS. SONG: Well, I believe the text shows that it can be controlled in

19   three different ways, by program schedule or where it says "of the user of

20   the system." And for example, they provide a utility company. But it

21   requires some sort of intervention, at the request of the utility company or as

22   programmed by the utility company. The system itself doesn't automatically

23   generate it in response to monitored remote devices.

24   JUDGE FETTING: You are not saying it's exclusive. I don't see

25   exclusively. I don't see anything in any language that excludes it being

1 responsive to something else in addition to what's claimed. So it could be

2 responsive to what's claimed based upon the way it was programmed.

3   MS. SONG: Well, the programming, we believe, would take it

4 outside of the scope of the claims because we're saying it's responsive to the

5 operating characteristics of the device. If you program it, you are telling it

6 when to work and at what time.

7   JUDGE FETTING: Not necessarily.

8   MS. SONG: That's all that Brown teaches. Brown teaches a schedule

9 and it says time and day and then time frame. That's all it says about the

10 program schedule. And the Examiner hasn't cited anything else that would

11 say that it goes beyond that. We're taking schedule to mean time of day and

12 time frame of operation of whatever devices.

13   JUDGE FISCHETTI: You know, I set my alarm clock last night and

14 this morning it automatically went off at 5:30. But last night I programmed

15 it to go off. So I humanly intervened and set the program last night and then

16 this morning the machine automatically took those instructions and went off.

17 I read Brown the same way.

18   MS. SONG: That's not how we read Brown. I guess the way that our

19 invention would work in your example is if rather than you intervening and

20 say what time that you need to wake up, the system would monitor -- would

21 have to monitor a device and see how it operates and then it would wake you

22 up.

23   I'm not really sure how that would apply in this situation because I

24 don't think that's a really good parallel but it would not require you to say,

25 This is when I want to wake up. It would monitor. Maybe it would know

26 from your schedule or it would know from some other source that that's

1   when you normally wake up and then it would wake you up. It wouldn't

2   require user intervention.

3   And the patent talks about a lot of different ways of doing this,

4   however, we've narrowed the claim. So we're taking out the program

5   schedule, user intervention. We're saying you monitor the remote devices.

6   Based on how it's operating, you can then automatically generate these

7   informational messages to then control, adjust, realign these remote devices.

8   I think I have addressed most of the rest of my points here. I just want

9   to touch upon the Woodard patent that was applied by the Examiner as

10   recognized by the office action. Brown does not disclose a server as

11   required by the claims. However, as a server an element is admittedly

12   missing from Brown.

13   Brown also fails to disclose the automatic generation of the

14   informational message because this function must occur at the central server.

15   The office action relies on the Woodard reference to address these

16   admitted deficiencies. However, Woodard merely collects and displays data

17   from multiple facilities. And just as Brown, Woodard does not disclose this

18   automatic generation of an informational message at a central server

19   responsive to operating characteristics of remote devices. The server in

20   Woodard simply does not provide this claim functionality.

21   Those are all the points that I wanted to make today. On behalf of our

22   client, ETGI, I thank you for the opportunity.

23   JUDGE FETTING: Thank you.

24   JUDGE LORIN: Thank you very much, counsel.

25   (Whereupon, the proceedings at 10:33 a.m., were concluded.)

9